

REMARKS

Claims 1, 9 and 10 are all the claims pending in the application.

Claims 1, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oharu et al. (U.S. Patent No. 6,610,775).

The Examiner recognizes that one of the differences between the invention of claims 1, 9 and 10 of the present application and Oharu et al is that Oharu et al does not disclose the specific isotridecyl groups of claim 1.

It is the Examiner's position that the broad disclosure of the alkyl chain of the non-ionic surfactants of Oharu et al at column 9, line 42 to column 10, line 11, includes the isotridecyl groups recited in present claim 1, since Oharu et al discloses that R¹⁰ may be of a linear structure or a branched structure (col. 9, lines 53-54).

Additionally, the Examiner criticizes the data in the specification as not being compared to the closest prior art.

Applicants respectfully traverse the rejection and submit that Oharu et al does not teach or suggest the present invention.

First, Applicants submit that none of the exemplified compounds of Oharu et al include an isotridecyl group and therefore is no motivation to employ such compound as suggested by the Examiner. At best, the Examiner is saying, in effect, that it is obvious to try any non-ionic surfactant having a branched or linear alkyl chain to arrive at the present invention. The applicable law is to the contrary. *See, e.g., In re Sigco*, 36 USPQ2d 1380, 1382 (Fed. Cir. 1995) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473, 5 USPQ2d 1521, 1532 (Fed. Cir. 1988))

(rejecting the "obvious to try" standard)); *In re Deuel*, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995) ("obvious to try" has long been held not to constitute obviousness").

Additionally, Oharu et al does not teach, suggest or recognize the advantageous effects that a surfactant having an isotridecyl group can give an aqueous water- and oil-repellent dispersion.

Applicants submit herewith a Declaration under 37 C.F.R. § 1.132, which explains the differences between the surfactant of the present invention and the surfactant taught by Oharu et al. The Declaration further shows that the present invention provides unexpectedly superior results when compared to the closest prior art based on a comparison of the inventive examples to Comparative Example 4 in the present specification, wherein polyoxypropylene polyoxyethylene cetyl ether is used, which corresponds to formula f of Oharu et al wherein the R¹⁰ group is the cetyl group (namely n-cetyl group) having the straight structure. Comparative Example 4, corresponding to Oharu et al, gives poor properties such as durability of repellency and mechanical property as shown in Table B at page 17 of the present specification. In contrast, inventive Examples 1-4, which use the surfactant having the isotridecyl group defined in present claim 1, gives excellent properties as shown in Table B. Thus, the present invention is patentable over Oharu et al.

Accordingly, Applicants respectfully request withdrawal of the rejection.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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